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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,974	10/09/2003	Toshio Yamamoto	VTN629NP	7789

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EXAMINER

KOPPIKAR, VIVEK D

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/681,974

Applicant(s)

YAMAMOTO ET AL. 

Examiner

Vivek D Koppikar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application

1. This communication is in response to the application filed on October 9, 2003 by the applicants. As of the date of this application no Information Disclosure Statement has been filed for this case. Claims 1-17 are pending in the application and have been examined.

Claim Objections

2. Claims 1 and 10-12 are objected to because of the following informalities.

As per claim 1, on line 6 of claim 1 “on” should be “one”. Appropriate correction is required.

As per claim 10, the meaning of the phrase “that cares for at least one of the at least one consumer” on lines 3-4 is unclear to the examiner. For the purposes of examination, the examiner will interpret this phrase as meaning that the doctor cares for at least one patient. Appropriate correction and/or clarification is required.

As per claims 11-12, the meaning of the term “contact item” (in line 7 and 10 of claim 11 and line 5 and 9 of Claim 12) is unclear. The examiner interprets the meaning of the term “contact item” to mean a prescription and specifically a prescription for contact lenses. The examiner recommends amended the claim to clarify this term.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Number 2004/0019794 to Moradi in view of US Patent Number 5,845,255 to Mayaud.

Moradi is directed towards a method and system for delivering prescription medicine while Mayaud is directed towards a prescription management system.

As per claim 1, which is directed towards a method of selling a prescribed product to a consumer via an online ordering system managed by or on behalf of a prescribed product manufacturer, Moradi teaches the steps of registering at least one authorized reseller of at least one product (Figure 9 and Section [0018]), registering at least one consumer to purchase at least one product on behalf of at least one patient for whom the product has been prescribed (Figure 7 and Section [0016]), assessing at least one approved prescription writer for the at least one product for the at least one patient (Section [0038]), accepting an approved prescription for the at least one product for the at least one patient approved from the prescription writer (Section [0039]), and issuing at least one product to the consumer in accordance with the calculated approved prescription (Section [0043]). The step of registering the customer is responsive to the authorized reseller inviting the customer to register (Figure 7 and Section [0131]).

Moradi fails to teach or suggest the step of performing at least one calculation on the approved prescription to generate a calculated approved prescription for the at least one product for the at least one patient and an actual wear schedule (dosage amounts based on a time period), however this feature is known in the art as evidenced by Mayaud

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(Col. 26, Ln. 39-Ln. 60). At the time the invention was made, one of ordinary skill in the art would have been motivated to add this dosage calculation feature to the system of Moradi in order to create a prescription management system with a minimized need for information, as recited in Mayaud (Col. 27, Ln. 13-18).

Neither Moradi nor Mayaud teach a feature wherein the calculated approved prescription includes a maximum amount of prescribed product that may be purchased under the calculated approved prescription, however, the examiner takes the position that a prescription, by its very definition, includes a maximum amount that can be purchased with each order (including the initial order and subsequent refills) and therefore in the system of Moradi the consumer would not be able to order more than an amount that has been prescribed for a particular user of the prescription.

As per claim 2, the combined system of Moradi in view of Mayaud includes managing at least two prescriptions each directly correspondent to one of at least two patients (Moradi, Abstract and Section [0160]).

As per claim 3, in the combined system of Moradi in view of Mayaud prescriptions can be ordered online and the specific types of prescriptions are not mentioned. The examiner therefore takes the position that ordering contact lenses is within the scope of the combined system of Moradi in view of Mayaud (Moradi; Section [0203]).

As per claim 4, the combined system of Moradi in view of Mayaud includes performing at least one calculation (Mayaud; Col. 26, Ln. 39-Ln. 60).

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As per claims 5 and 6, in the combined system of Moradi in view of Mayaud the step of issuing comprises selling and delivering the product to the customer (Moradi; Section [0200]).

As per claim 7, in the combined system of Moradi in view of Mayaud the step of issuing comprises selling the product to at least one reseller and delivering the product to the customer (Moradi; Section [0035]).

As per claims 8-9, in the combined system of Moradi in view of Mayaud there is a charge account dedicated to the reseller (doctor) and the account is set up during the registration process (Sections, [0131]-[0133 and [0148]).

As per claim 10, in the combined system of Moradi in view of Mayaud the step of assessing the approved prescription writer (doctor) comprises registering the doctor with the reseller. The doctor cares for one or more patients (Sections [0108]-[0109]).

As per claim 11, in the combined system of Moradi in view of Mayaud the step of inviting the customer comprises a) receiving a calculated approved prescription from the authorized reseller (Mayaud; Col. 26, Ln. 39-Ln. 60), assessing that the customer related to the calculated approved amount is not registered (Moradi; Section [0035]), receiving, from the authorized reseller, at least one contact item (prescription) for the customer related to the calculated approved prescription (Moradi, Section [0200]), and inviting the customer related to the calculated approved prescription to register based on the one contact (prescription) item (Moradi, Figure 8 and Section [0160]).

As per claim 12, in the combined system of Moradi in view of Mayaud comprises the steps of assessing that the at least one customer related to the calculated approved prescription is not registered (Moradi; Section [0035]), receiving, from the authorized

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reseller, at least one contact item (prescription) for the customer related to the calculated approved prescription (Moradi; Section [0200]), inviting the customer related to the calculated approved prescription to register based upon the one contact item (Moradi; Figure 8 and Section [0160]) and receiving a calculated approved prescription from the authorized reseller (Mayaud; Col. 26, Ln. 39-Ln. 60).

As per claim 15, in the combined system of Moradi in view of Mayaud the consumer (doctor) may order products for multiple patients (Moradi; Sections [0050]-[0051]).

As per claim 16, in the combined system of Moradi in view of Mayaud multiple products are shipped to the consumer in one shipment (Figure 10 and Section [0200]).

Claim 17 includes the same limitations as claim 1 but is directed towards a system rather than a method and is therefore rejected for the same reasons as claim 1 is rejected (see the paragraph for the rejection of claim 1).

5. Claims 13-14 are rejected under 35 U.S.C. 103(a) as applied to Claims 1, 11 and 12 above over Moradi in view of Mayaud.

Moradi in view of Mayaud fail to teach or suggest inviting the customer to register by an email or phone invitation, however the examiner takes the position that these features are well known in the art and the examiner takes Official Notice. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included an email and/or phone invitation system in the combined system of Moradi in view of Mayaud with the motivation of providing an efficient means of informing a user to register with the automated prescription sales system.

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Further, since the knowledge and use of telephone and email invitations, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

www.bestcontacts.com discloses a website for ordering contact lenses. This particular website was published on June 9, 2002.

7. Inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-5356**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306.

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8 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VK

Vivek Koppikar

8/30/04

Joseph Thomas
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